

REMARKS

1. The Restriction Requirement

The Examiner has required restriction under 35 U.S.C. Sections 121 and 372. According to the Examiner, the application contains four groups of claims that define subject matter which lacks unity of invention under PCT rule 13.1 because, under PCT rule 13.2, the technical feature identified by the Examiner as common to the claims fails to make a contribution over the prior art. Under the Examiner's classification scheme, pending claims 1-13 are grouped as follows:

Group I, claims 1-4, drawn to a method for restoring rice fertility comprising introducing a nucleotide sequence into rice;

Group II, claims 5-9, drawn to a method for discerning whether a subject rice individual or a seed thereof has the rice restorer gene or not by using a nucleotide sequence encoding the polypeptide of SEQ. ID. NO. 75 or variants thereof;

Group III, claims 10-11, drawn to a method for inhibiting the rice restorer gene by using an antisense nucleotide sequence; and

Group IV, claims 12-13, drawn to a nucleotide sequence encoding a polypeptide of SEQ. ID NO. 75 or variants thereof. (Office Action, page 2).

The Examiner's detailed reasoning for making the above-discussed findings appears on pages 2-3 of the Office Action, and is not reproduced here.

The Examiner has imposed a further level of restriction, requiring Applicants to elect one nucleotide sequence from SEQ ID NOs 27, 69-74 and 80-85. The Examiner's detailed reasoning for imposing this second level of restriction appears on pages 3-4 of the Office Action, and is not reproduced here.

Applicants respectfully traverse both levels of restriction.

Applicants point out that, under a full implementation of the Examiner's restriction scheme, Applicants would be forced to file and prosecute 48 patent applications to obtain patent protection for the inventive methods and nucleic acid products contained in this application. The content of the patents issued under the Examiner's restriction scheme would be as follows:

- 24 of the patents would contain a mere 4 claims,
- 24 of the patents would contain a mere 2 claims, and
- all of the patents would recite only a single nucleotide sequence.

Applicants submit that this restriction scheme is excessive, and point out that being forced to execute the Examiner's restriction scheme places an undue and unreasonable financial burden on them. Applicants further point out that there are 13 claims pending in this application, and submit that examining this number of claims, including all of the nucleotide sequences recited therein, in a single application does not impose an undue search or examination burden on the Examiner.

In addition, Applicants point out that, under 35 U.S.C. § 121, an Examiner can make a restriction requirement between different groups of claims but cannot properly restrict an application by dividing up the subject matter of a single generic claim by making a restriction within that claim. An Examiner may not, in this manner, simply refuse to make an examination on the merits of a broad generic claim. Such a refusal is tantamount to attempting to reject the claim under 35 U.S.C. § 121, a rejection which has been viewed with disapproval by the court. The incorrectness of the Examiner's apparent reasoning was specifically explained by Judge Rich:

"it is elementary patent law that the number of "species" "covered" by a patent having a generic claim is virtually without limit notwithstanding the limitation of rule 141 to five species "specifically claimed". So the discretionary power to limit one application to one invention is no excuse at all for refusing to examine a broad generic claim – no matter how broad, which means no matter how many independently patentable inventions may fall within it."

In re Weber, 198 USPQ 328, 331-332 (CCPA 1978).

For the foregoing reasons, Applicants respectfully request that the Examiner rejoin all of the claims and sequences for examination a single application.

Finally, Applicants point out that SEQ ID NO: 69 is a subsequence of SEQ ID NO: 27, and submit that a search for SEQ ID NO: 69 will therefore reveal prior art for SEQ ID NO: 27. Accordingly, the examination of both SEQ ID NOs 27 and 69 in a single application would not pose an undue search burden; and Applicants request, at the very least, rejoinder of SEQ ID NOs 27 and 69.

In order to be fully compliant with the Restriction Requirement, Applicants elect, with traverse as to both elections, the claims of Group I and SEQ ID NO: 69.

2. Conclusion

Applicants respectfully request rejoinder of all claims and nucleic acid sequences for examination in a single application, and request favorable and early action on the application.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Mark J. Nuell, Registration No 36,623 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant(s) respectfully petition(s) for a one (1) month extension of time for filing a reply in connection with the present application, and the required fee is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

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Respectfully submitted,

By mark Nuell

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